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PATENT

Customer No. 22,852

Attorney Docket No. 03495-0203-00000

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Ute ROGNER, et al.

Serial No.: 09/847,665

Filed: May 3, 2001

For: IDENTIFICATION OF NEURAL
DEFECTS ASSOCIATED WITH
THE NUCLEOSOMAL ASSEMBLY
PROTEIN 112 GENE

Commissioner for Patents and Trademarks
Washington, DC 20231

Sir:

RESPONSE TO RESTRICTION REQUIREMENT

In a restriction requirement dated September 30, 2002, Paper No. 9, the Office required restriction under 35 U.S.C. § 121 between

- I. Claims 1-3, 5, 9-10, and 54 drawn to a method for screening neural system defects in chromosomal material of mammal by DNA hybridization with a labeled probe, classified in class 435, subclass 6, for example.
- II. Claims 6-7, and 55 drawn to a method for screening neural system defects using an antibody, classified in class 435, subclass 7.1, for example.
- III. Claims 15-20, 22, 24-26, 33-36, 40-41, 45-48, and 56-61 to polynucleotide, vectors, and cells comprising the same, classified in class 536, subclass 23.1, for example.
- IV. Claims 27 and 37-38, drawn to a method of screening for therapeutic compounds comprising introducing to a cell a compound to be screened, classification dependent upon compound structure.

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- V. Claim 28, a method of screening for therapeutic compounds comprising introducing a compound to be screened to a transgenic knockout animal, classified in class 800, subclass 9, for example.
- VI. Claim 39, drawn to a method of increasing the expression of *NAP1L2* gene in tumoral human neural cells or for decreasing the expression of *Nap1/2* gene in human neural cells afflicted by a degenerating disease, comprising administering a compound, classification dependent upon compound structure.
- VII. Claim 49, drawn to a method for targeted expression of a polypeptide in a neural cell, classification dependent upon how expression is targeted.

Applicants provisionally elect to prosecute Group III, claims 15-20, 22, 24-26, 33-36, 40-41, 45-48, and 56-61, drawn to polynucleotide, vectors, and cells comprising the same. In addition, Applicants provisionally elect Group B, drawn to SEQ ID NO: 4, for prosecution.

Furthermore, Applicants provisionally elect the species of a wild type animal for prosecution. Applicants respectfully submit that the requirement of election of species between the five groups provided is not proper. Even if claims drawn to a) immortal cell lines, b) neuronal cell lines, c) tumor derived cell lines, d) embryonic stem cells, or e) wild type animals, are different inventions, "[i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits even though it includes claims to independent or distinct inventions." M.P.E.P. § 803. Applicants submit that the subject matter of the claims in these different groups would encompass the same search, and therefore would not be a serious burden.

Because the Office has not provided any reasons why the examination of all of the species would be a burden, Applicants respectfully request that the restriction requirement be withdrawn and all of the pending claims be considered together.

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Please grant any extensions of time required to enter this response and charge
any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: October 30, 2002

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